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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/769,365	01/30/2004	Russell E. Malz JR.	0177-PC	7899

7590

02/07/2005

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EXAMINER

DAVIS, BRIAN J

ART UNIT

PAPER NUMBER

1621

DATE MAILED: 02/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/769,365	Applicant(s) MALZ ET AL.	
	Examiner Brian J. Davis	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on ____.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-14 is/are pending in the application.

4a) Of the above claim(s) ____ is/are withdrawn from consideration.

5) ☐ Claim(s) ____ is/are allowed.

6) ☒ Claim(s) 1-14 is/are rejected.

7) ☒ Claim(s) 14 is/are objected to.

8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 1/30/04;9/27/04.

4) ☐ Interview Summary (PTO-413)
 Paper No(s)/Mail Date. ____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: ____.

DETAILED ACTION

Claim Objections

Claim 14 is objected to because of the following informalities: the claim contains an obvious typo ("...theortho...") and does not end with a period. Claims must begin with a capital letter and end with a period. MPEP 608.01(m). Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The exact meaning of the word "predominantly" is unclear. That is, the term is unclear both as to the method of measurement (weight, molar amount, etc.), as well as exactly what amount of the desired ortho-substituted product is a "predominate" amount.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "a small amount of water" is unclear. In a like manner as that outlined above, the exact meaning of the phrase "a small amount" is unclear. That is, the phrase is unclear both as to the method of measurement, as well

as exactly what amount of water constitutes a small amount. A similar analysis holds for the word "amounts" which appears in the phrase "...[desired product] is formed in *amounts* equal to or greater than any concurrently formed [byproduct]."

The remaining claims are also rejected under 35 USC 112, second paragraph, as claims which depend from indefinite claims are also indefinite. *Ex parte Cordova*, 10 USPQ 2d 1949, 1952 (PTO Bd. App. 1989).

Allowable Subject Matter

All claims would be allowable once the above objection and 112 rejections have been overcome. The following is a statement of reasons for the indication of allowable subject matter:

The closest prior art appears to be US 5,574,187 and US 5,689,007, cited by the applicant in the IDS and discussed in the specification, which teach the synthesis of para-substituted phenyl amines from phenylhydroxylamine and a nucleophilic reagent (such as aniline) using, inter alia, as catalysts the oxides of Ti, Zr, Hf, V, Nb, Ta, Si and Al (abstract; column 4 line 22). (The examiner notes for clarity of the record that US 5,689,007 contains obvious typographical errors with regard to the labeling and listing of metals.) The ortho-substituted products of the instant invention are neither taught nor suggested by the cited prior art, nor are the instant Manganese oxide catalysts. Nor would it have been obvious to one of ordinary skill in the art at the time of invention to modify the process of the prior art in order to arrive at that of the instant invention. There is no motivation to do so.

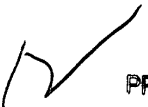
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: US 2,714,614 is cited to show a related process.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 571-272-0638. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


BRIAN DAVIS
PRIMARY EXAMINER
Brian J. Davis
February 3, 2005